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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,450	01/04/2001	Hiroshi Sugiyama	05225.0192	3423

22852 7590 08/11/2005

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EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/753,450

Applicant(s)

SUGIYAMA ET AL.

Examiner

James W. Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/7/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 7, 2005 has been entered. Per the request for continued examination, the after-final amendment submitted on April 7, 2005 has been entered.

Response to Amendment

2. The amendment filed on April 7, 2005 under 37 CFR 1.116 has been considered but is ineffective to overcome the Henson (6,167,383), Burke (5,848,399) and Storey (5,774,870) references. The amendment did not add any new claims nor cancel any existing claims, but amended claims 1, 2, 5-7, 9, 11, 14, 16,18, 21, 23-33, and the specification. The changes to the specification are hereby approved and have been entered. Thus, the currently pending claims considered below remain Claims 1-33.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 and 16-20, and 23-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell (5,890,135).

Claims 1, 2, and 24-33: Powell discloses a system, apparatus, method and computer program for distributing information, comprising

a. Storing, selecting, and retrieving from an information distribution apparatus coupon information usable to purchase a product or service by a user (col 3, lines 44-57);

b. Receiving and displaying the selected coupon information at a user terminal and storing the coupon information on a second communication unit (customer card)(col 3, lines 44-57); and

c. Receiving coupon information at a sales apparatus located in a store from the second communication unit, redeeming the coupon during a purchase transaction, logging the redeemed coupon information, and selecting and executing the settlement program (based on the type/issuer of the coupon) for settling the coupon account with the coupon issuer (i.e. communicating the redemption information to the appropriate coupon clearinghouse or coupon issuer)(col 7, lines 40-49).

While Powell does not explicitly disclose that a wireless communication network is being used to transmit the information and data between the various nodes, Official Notice is taken that wireless connections to various communication networks, such as telephone, television, and computer networks, are old and well known. Wireless and

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cellular telephones, personal data assistants (PDA's), laptop and desktop computers, and IR or RF smart cards all were well known and widely used examples of wireless communication system within our society at the time of the present invention and have been developed and used to allow the users more mobility. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to connect the terminals in Powell using known wireless technology. One would have been motivated to use wireless technology to connect the nodes in order to allow the user to purchase items from the seller at whatever location the user may be in at the time, i.e. increase mobility. The Examiner further notes that whether the communication network is a wired or a wireless does not affect the steps of the claimed methods. The information distribution apparatus, the terminal apparatus, and the sales apparatus in Claim 1 would perform the same steps whether their "communication units" were coupled to a wired or wireless connection. Therefore, little, if any, patentable weight is given to the type of connection through which the information and data is passed.

Claim 3: Powell discloses a system for distributing information as in Claim 2 above, and further discloses displaying a coupon to the user with various information (Figure 16 and col 7, lines 40-49). While it is not explicitly disclosed that information on the coupon includes a purchase information identifier, an object commodity name, a privilege (i.e. discount), an object store name, and a classification name, these are common information usually found on coupons. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include at least the claimed information on the coupon. One would have been motivated to include

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such information in order to more easily identify and track the usage of the coupon and to better inform the user of the terms of the coupon (i.e. where, when, and for how much the coupon could be used) as discussed by Powell.

Claim 4: Powell discloses a system for distributing information as in Claim 1 above, and further discloses displaying coupons usable at stores local to the user's present location (geographic location)(col 6, lines 28-46 and col 7, lines 40-49).

Claim 5: Powell discloses a system for distributing information as in Claim 1, and further discloses transmitting the stored log information, which includes at least the identification of the store and of the customer who presented the coupon for redemption (col 7, lines 40-49). While it is not explicitly disclosed that the log information also includes a purchase information identifier (i.e. product code) or a use date (redemption date), the Examiner notes that these two types of data are the normal type of information stored when tracking usage of coupons as Powell discloses and would have been obvious to one having ordinary skill in the art at the time the invention was made to track and store at least these types of information in Powell. One would have been motivated to store the usage date and product identifier in order to allow the coupon issuer to make a more meaningful analysis of their promotional program as is common in the marketing arts as discussed by Powell.

Claim 6: Powell discloses a system for distributing information as in Claim 1 above, and further discloses transmitting and storing purchase information, such as information pertaining to a quantity discount for purchasing a certain quantity of a product within a defined time period (col 8, line 48 – col 9, line 9).

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Claim 7: Powell discloses a system for distributing information as in Claim 1 above, and further discloses selecting the information based on matching criteria with the coupon information (col 6, lines 29-61).

Claim 8: Powell discloses a system for distributing information as in Claim 1 above, and further discloses displaying the coupon information at the terminal apparatus and transmitting the coupon information to the sales terminal (col 10, lines 34-44).

Claims 9 and 20: Powell discloses a system for distributing information as in Claims 6 and 19 above, and further discloses issuing a proof of purchase (col 13, lines 3-57).

Claim 10: Powell discloses a system for distributing information as in Claim 9 above. While Powell discloses providing recommendations as part of the merchandising messages presented to the customer (Figure 16), it is not explicitly disclosed that the recommendation information includes a purchase information identifier, an object store name, and a classification name. However, it would have been obvious to one having ordinary skill in the art of speaking that any information to include the claimed identifier, store name, and classification, could be included in the recommendation communicated to the user in Powell. One would have been motivated to communication this type of information to the user in order to inform the user about where a particular purchase was made and for what type of product or service.

Claims 16-19: Powell discloses a system for distributing information as in Claim 6 above, but does not explicitly disclose that the purchase information pertains to a travel itinerary used to purchase transportation tickets or to an electronic trading system used to purchase shares of stock. However, the Examiner notes that the type of product or service being purchased by the user does not affect the claimed steps of using the purchase information to display messages to the user and is, therefore, given little if any patentable weight. It would have been obvious to one having ordinary skill in the art that the system and method described in Powell and claimed in the present invention could be used with purchase information from any type of product or service transaction. One would have been motivated to extend the use to travel and stock purchases in order to increase the utility of the system.

While Powell also does not explicitly disclose that the user is using a "vending machine" as the sales apparatus, Official Notice is taken that unattended sales apparatuses (i.e. vending machines) are very old and well known within the retail arts. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the user in Powell to utilize a vending machine to purchase the desired product(s). One would have been motivated to allow the user to purchase the product via a vending machine or kiosk in order to allow use of the system during hours when the store is not open for business (by placing the vending machine in public places, such as airport or railway terminals).

Claim 23: Powell discloses a system for distributing information as in Claim 1 above, and further discloses tracking the use of the system to include the merchandising information (e.g. coupons) displayed to the user (col 7, lines 40-49). While Powell does not explicitly disclose that the coupon issuer (advertiser) is charged for the distribution of their information to the user, Official Notice is taken that it is old and well known throughout the marketing arts for advertisers to pay a third party, such as the system in Powell, to display their promotional information. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to charge the store (advertiser) for displaying the information to the user in Powell. One would have been motivated to charge the store in order to maintain financial viability of the system.

5. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell (5,890,135) in view of Henson (6,167,383).

Claims 21 and 22: Powell discloses a system for distributing information as in Claim 1 above, but does not explicitly disclose receiving and using consumer feedback to select information to provide to the consumer. However, Henson discloses a similar system for distributing information which further discloses receiving user feedback (selections) and analyzing such feedback to select information to provide to the user, e.g. recommendations for additional equipment or on the compatibility of the selected equipment. (col 7, lines 29-38). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to receive and utilize

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consumer feedback when selecting the coupon information to send to the users in Powell. One would have been motivated to use such feedback in order to present a more targeted coupon offer to the user, thus increasing the likelihood of acceptance by the user, which has been the goal of every targeted marketing system throughout history.

6. Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell (5,890,135) in view of Storey (5,774,870).

Claim 11: Powell disclose a system for distributing information as in Claim 1 above, but does not explicitly disclose that the purchase information could be promotional information pertaining to games and prizes. However, Storey discloses a similar system for distributing information which further discloses that the information could be promotional information pertaining to games or coupons in which the user may earn prize points for purchases (col 1, line 57 – col 2, line 27 and col 8, line 3 – col 10, line 6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to award points to users in Powell. One would have been motivated to award points to the user in order to entice the use to increase participation/utilization of the system.

Claim 12: Powell and Storey disclose a system for distributing information to include awarding prize points to the user as in Claim 11 above, and Storey further discloses the prize information containing at least the commodity name, a number of points, a number of necessary points, and a classification name (col 1, line 57 – col 2,

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line 27 and col 8, line 3 – col 10, line 6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such data in the prize information in Powell. One would have been motivated to include this data in order to allow the merchant to better track the promotional program and the number of points outstanding by each user.

Claim 13: Powell and Storey disclose a system for distributing information to include awarding prize points as in Claim 12 above, and Storey further discloses awarding the prize to the user if the number of points exceeds the number of points necessary for the prize (col 1, line 57 – col 2, line 27 and col 8, line 3 – col 10, line 6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to award the prize to the user in Powell once the required number of points had been earned. One would have been motivated to award the prize in this manner in order to entice the user to earn more points.

Claim 14: Powell and Storey disclose a system for distributing information to include awarding prize points to the user as in Claim 1 (and 14) above, and Storey further discloses registering the user (setting up an award point account for the user) and tracking the frequency of use of the system by the user, which is then used to award points (col 1, line 57 – col 2, line 27 and col 5, lines 36-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to register the user in Powell and to award points based on the frequency of access by the user. One would have been motivated to register the user in order to better track the users of the system. One would have been motivated to award points

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based on the usage of the system in order to entice the user to utilize the system more frequently.

Claim 15: Powell and Storey disclose a system for distributing information to include awarding prize points as in Claim 14 above, and Storey further discloses updating the prize points database each time the user earns or redeems points (col 5, lines 36-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to update the user's points account. One would have been motivated to update the points account in order to enable the award system to function.

Response to Arguments

7. Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Ruppert et al (5,640,002) discloses a system and method for distributing coupon information using a wireless tag (card) for storing and transmitting coupon data to a POS terminal.

b. Herz et al(6,571,279) discloses a system and method for distributing advertising and coupon information using wireless technology.

c. Atsmon et al (6,607,136) discloses a system and method for distributing coupon information over the internet to a user's electronic card for transport to a POS terminal.


d. Marshall et al (6,650,429) discloses a system and method for distributing coupons to the pager of a user.

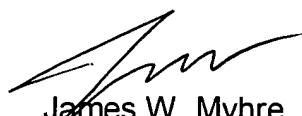
e. Swartz et al (6,837,436) discloses a system and method for distributing shopping information to include coupons to a user over the internet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (571) 272-6724. The fax phone number for Formal or Official faxes to Technology Center 3600 is (571) 273-8300. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 273-6722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-3600.


JWM
August 8, 2005


James W. Myhre
Primary Examiner
Art Unit 3622